



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/261,329	03/03/1999	KIM VILBOUR ANDERSEN	4887.204-US	7632
25908	7590	03/25/2004		
NOVOZYMES NORTH AMERICA, INC. 500 FIFTH AVENUE SUITE 1600 NEW YORK, NY 10110			EXAMINER SLOBODYANSKY, ELIZABETH	
			ART UNIT 1652	PAPER NUMBER

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/261,329	Applicant(s) ANDERSEN ET AL.	
	Examiner Elizabeth Slobodyansky, PhD	Art Unit 1652	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 04 March 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: 203.

Claim(s) rejected: 148,183,197,198,200 and 202.

Claim(s) withdrawn from consideration: 149-182,184-196,199 and 201.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

E. Slobodyansky
Elizabeth Slobodyansky, PhD
Primary Examiner
Art Unit: 1652

Continuation of 2. NOTE: The scope of the claims has been changed by the amendment requiring additional consideration. Claims 204-206 would require the 112, 2nd paragraph, rejection because the reference to SEQ ID NO:1 renders the claims unclear. Further, claims 205-206 are incomplete as dependent from canceled claim 148. The amendment does not overcome at least the 112, 1st paragraph, rejections.

Continuation of 5. for the reasons of record in view of non-entry of the amendment. Applicants argue that "The claimed invention is drawn to variants of a cellulase of SEQ ID NO:5 comprising a substitution at position 119 with H" (Remarks, page 5). Applicants assert that said variants are described and enabled because "The specification describes a number of other positions, including specific mutations, which can be combined with the claimed substitution. Moreover, other positions for mutation have been described in the art" (page 4). This is not persuasive because the number of mutations in claims 204 and 206 is not limited. Applicants argue that "the Office is incorrect that the claimed variants are not defined by structure. The claims specify that the parent cellulase is the cellulase of SEQ ID NO:5 and that the variant has endoglucanase activity. Thus, the structure of the claimed variants is inherent" (page 5). This is not agree with because the claims do not define the difference between the structure of a variant and the parent cellulase resulting in a variant that has an unknown and possibly very low homology with SEQ ID NO:5.